

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 18, 20-23, and 35-36, 38-39 are pending in the application, with claims 18, 38, and 39 being independent claims. Claims 1-17, 19, 24-31, 32-34, 37, and 40-42 were previously cancelled. Claim 18 is sought to be amended by removing "alkyl" as a possible R₁ group. Excluding members of a Markush group does not violate the written description requirement. See *In re Johnson and Farnham* 194 USPQ 187 (CCPA 1977). New claims 38 and 39 are sought to be added. Similarly to new claim 18, new claim 38 excludes "alkyl" as an R₁ group under a narrower set of circumstances. Support for new claim 38 can be found, in Formula III, on page 7, lines 5 to 19, and lines 1-7 of page 8 of the originally filed specification. Support for new claim 39 can be deduced from the combination of claim 18 and claim 20 by incorporating the limitations of claim 20 into claim 18. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Applicants respectfully request that the Examiner clarify the objection to claim 19 since it was cancelled in a previous amendment filed June 4, 2008. Subsequently, Applicants will consider the objections directed toward claims 20-22, 35, and 36.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 103(a)

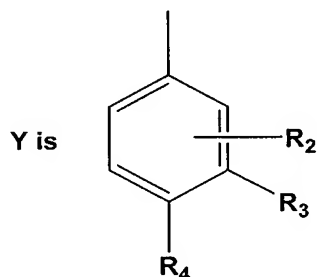
Claims 18 and 23 were rejected under 35 U.S.C. §103(a), as allegedly being obvious over Haider, *et al.*, *Scientia Pharmaceutica* (1996), 64(3/4), 399-405 (Office Action, page 3). Applicants respectfully traverse this rejection.

The Examiner asserts that "[t]he presently claimed compounds are obvious over Haider as methyl homologs thereof and obviously suggested to the skilled practitioner for the same utility." Office Action at page 3. Additionally, the Examiner objects to claims 20-22, 35 and 36 since they are dependent on a rejected claim. As amended, the claims are directed to compounds which would render the rejections and objections by the Examiner moot.

By removing the term "alkyl" as a substitute for R₁, the possibility of the compound in claim 18 cannot be considered a methyl homolog similar to the compound in Haider. The remaining possible substituents for R₁ as defined in claim 18 can not be arrived at by making an adjacent homolog of the prior art compound. Consequently, there would not be a reasonable expectation of success since the aforementioned substitutions are not methyl homologs. As such, a *prima facie* case of obviousness has not been made. Additionally, with the amendment made to claim 18, the rejection toward claim 23 would be moot since claim 23 is dependent on claim 18.

Furthermore, new claims 38 and 39 are not obvious over Haider. Specifically, the claim limitations listed in claims 38 and 39 are not described nor suggested by Haider. Claim 38 incorporates the same limitations as claim 18 in that "alkyl" is not a possible substitute for R₁ under specific conditions; namely, when X is O, Y is unsubstituted phenyl, and R₅ and R₈ are hydrogen, then R₁ is not alkyl. Similarly, claim

39 combines claims 18 and 20 by incorporating the limitations of claim 20 into claim 18 such that the following structure for Y is:



R₂ is H, alkyl, halo, amino, alkoxy, or nitro; and

R₃ and R₄ are taken together to form a five or six membered carbocyclic or heterocyclic ring.

Since each of the claims defines subject matter not described or fairly suggested by Haider, Applicants respectfully request the Examiner to reconsider and withdraw the obviousness rejection.

Objections under 35 U.S.C. § 103(a)

Applicants note with appreciation the indication that claims 20-22, 35, and 36 include allowable subject matter "if rewritten in independent form including all of the limitations of the base claim and any intervening claims." Office Action at pages 4 to 5. Claims 20-22, 35, and 36 are dependent on new claim 18, as amended above, and as such are no longer dependent upon a rejected base claim. Additionally, claim 39 is a combination of claims 18 and 20 such that claim 39 incorporates the limitations of claim 20 into claim 18 as noted above.

Since each of the objected claims no longer depends upon a rejected base claim, Applicants respectfully request the Examiner to reconsider and withdraw the objections to claims 20-22, 35, and 36.

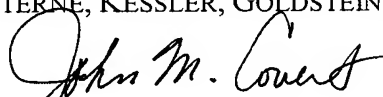
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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